

REMARKS

The Examiner has allowed claims 10-24 of the subject application. In the Notice of Allowability of June 15, 2005, the Examiner denied Applicant's claim for domestic priority to certain prior-filed provisional applications and amended the Specification to delete references to those provisional applications. Applicant is submitting herewith an amendment to the Specification to reinsert references to two of those provisional applications. Applicant respectfully requests entry of this amendment, which is in response to the Examiner's amendment.

Claim for Domestic Priority

As filed, the subject application claimed the benefit of three prior-filed provisional applications, namely U.S. Provisional Application Nos. 60/429,252 ('252 application), 60/400,265 ('265 application), and 60/412,155 ('155 application). In denying Applicant's claim for domestic priority, the Examiner contends that the '252 application shares no common inventors with the subject application and fails to provide adequate support under 35 U.S.C. §112 for any aspect of the claimed invention. Also, the Examiner contends that the '265 application fails to provide adequate support for claims 1-12 and 19-24 of the subject application, and that the '155 application fails to provide adequate support for claim 10 of the subject application.

In an effort to expedite the prosecution of the subject application, Applicant hereby withdraws the claim for domestic priority with respect to the '252 application, without prejudice or disclaimer of the subject matter contained therein. However, Applicant maintains the claim for domestic priority with respect to the '265 application and the '155 application for at least the reasons set forth below.

37 C.F.R. §1.78 sets forth the requirements for claiming the benefit of an earlier filing date. In particular, 37 C.F.R. §1.78 states in relevant part:

A nonprovisional application ... may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in *at least one claim* of the later-filed

application in the manner provided by the first paragraph of 35 U.S.C. 112.

37 C.F.R. §1.78(a)(4) (emphasis added).

Thus, a later-filed nonprovisional application can claim the benefit of a prior-filed provisional application if: (a) the prior-filed provisional application shares at least one common inventor with the later-filed nonprovisional application; and (b) the prior-filed provisional application provides adequate support under 35 U.S.C. §112, first paragraph, for at least one claim of the later-filed nonprovisional application. With respect to the latter requirement, the prior-filed provisional application need not provide adequate support for each and every claim of the later-filed nonprovisional application, as long as the prior-filed provisional application provides adequate support for at least one claim. *See* 37 C.F.R. §1.78(a)(4). Moreover, the prior-filed provisional application can provide adequate support through incorporation by reference. *See* M.P.E.P. §608.01(p)(I)(B). Indeed, the M.P.E.P. states that “an application is entitled to rely upon the filing date of an earlier application, even if the earlier application itself incorporates essential material by reference to another document.” *Id.*

Applicant respectfully submits that the subject application is entitled to the benefit of the ‘265 application and the ‘155 application since: (a) each of these prior-filed provisional application shares at least one common inventor with the subject application; and (b) each of these prior-filed provisional application provides adequate support under 35 U.S.C. §112, first paragraph, for at least one claim of the subject application.

In particular, the ‘265 application and the subject application share at least one common inventor, including L. Ross, D. Fengels, J. Mault, and E. Pearce. Moreover, the ‘265 application provides adequate support under 35 U.S.C. §112, first paragraph, for at least one claim of the subject application, such as claim 13. Support for claim 13 of the subject application can be found in at least the following portions of the disclosure of the ‘265 application: page 3, lines 5-14; page 4, lines 10-17; page 6, line 14 to page 7, line 18; page 17, line 16 to page 20, line 5; and Figs. 14-17. By showing support for claim 13, Applicant is in no way expressing agreement with or acquiescing to the Examiner’s contentions with respect to claims 1-12 and 19-24 of the subject application.

Likewise, the ‘155 application and the subject application share at least one common inventor, including E. Pearce, T. Kilbourn, C. Sandys, and J. Mault. Moreover, the ‘155 application provides adequate support under 35 U.S.C. §112, first paragraph, for at least one

claim of the subject application, such as claim 13. The '155 application incorporates by reference the disclosure of U.S. Patent Application No. 09/630,398, which has issued as U.S. Patent No. 6,468,222 ('222 patent). Support for claim 13 of the subject application can be found in at least the following portions of the incorporated disclosure of the '222 patent: column 3, line 48 to column 4, line 30; column 6, line 66 to column 7, line 55; column 8, lines 15-53; and column 16, line 25 to column 17, line 17. By showing support for claim 13, Applicant is in no way expressing agreement with or acquiescing to the Examiner's contentions with respect to claim 10 of the subject application.

Summary

For at least the reasons set forth above, Applicant respectfully requests grant of the claim for domestic priority with respect to the '265 application and the '155 application. Along this regard, Applicant respectfully requests entry of the amendment to the Specification to reinsert references to these prior-filed provisional applications.


If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 843-5852.

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COOLEY GODWARD LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

Respectfully submitted,
COOLEY GODWARD LLP

By:



Cliff Z. Liu
Reg. No. 50,834